

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 13, 2010. Claims 1-12, 14-38, and 40-55 are pending in the Application. In the Office Action, Claims 13 and 39 were previously cancelled. Claims 1-12, 14-38, and 40-55 were rejected.

In order to expedite prosecution of this Application, Applicants amend Claims 1, 27 and 55. Thus, Claims 1-12, 14-38, and 40-55 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

I. 35 U.S.C. §103 Obviousness Rejection of Claims

Claims 1-12, 14-38, and 40-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,343,251 (hereinafter “Nafeh”) in view of U.S. Patent No. 7,088,909 (hereinafter “Wordemann”) in view of U.S. Patent No. 6,169,542 (hereinafter “Hooks”) in view of U.S. Patent No. 6,100,941 (hereinafter “Dimitrova”) and in view of U.S. Patent Publication No. 2005/0262539 (hereinafter “Barton”). Applicants respectfully traverse this rejection.

The Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984) (emphasis added). Additionally, Patent Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *See* MPEP, § 2141 (emphasis added). In addition, a prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. *See* MPEP, § 2145. Further, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1, 82 USPQ2d at 1396 (2007).

Prior to the Examiner receiving this Response, Applicants will attempt to contact the Examiner to discuss the important key principles and differences between the cited art and Applicants invention. In particular, Applicants emphasizes that one of the important purposes of the present application is not to remove, skip, or replace commercial messages as taught by the prior art, but rather to store, retrieve and view/listen to the commercial messages based on user selections. (See p. 3, Brief Summary of the Invention) The minor amendments further clarify this purpose with the intent to reach allowable subject matter.

In relevant part, independent claim 1 recites (emphasis added):

A signal processing device comprising:
commercial message section detecting means for detecting a commercial message section from an input signal including at least the commercial message section and the remaining signal section on a time division basis, wherein a start time of a commercial message and a length of the commercial message section are detected by the commercial message section detecting means;
a commercial message extracting means for extracting the commercial message in the commercial message section from the input signal in accordance with a result of the detection by the commercial message section detecting means, the commercial message being extracted for subsequent access by a user, the access including playing back the commercial message in response to a user selection;
a recording means for recording each commercial message for subsequent access by the user in response to the user selection, the commercial message being extracted from the input signal by the commercial message extracting means;
an index information extracting means for extracting information from said commercial message section to be used as a user-selectable index representing said recorded commercial message, the information extracted from said commercial message section and associated with said commercial message being one of a starting image, a cut point image, a starting sound or an ending sound; and
a display means for displaying said index, the display means further playing back a selected commercial message audibly and/or visually in response to a user selection from the index, the index including a plurality of commercial messages recorded by the recording means that are selectable by the user for playback.

The method cited in claim 1 is clearly unlike Nafeh, Wordemann, Hooks, Dimitrova, and Barton alone or in combination, each of which fails to suggest, teach, or disclose “the commercial message being extracted for subsequent access by a user, the access including playing back the commercial message in response to a user selection.” Instead, Nafeh teaches a system utilized to “classify programs and commercials, and to eliminate commercial recordings on a VCR as illustrated in FIG. 2.” (Nafeh, col. 3, lines 51-54) Likewise, Wordemann teaches a method that “enables programme parts, such as advertising blocks, to be reliably masked out, so that undesirable masking out of scenes of the programme contributions does not occur.” (Wordemann, col. 1, lines 49-55) Dimitrova similarly teaches substituting or skipping commercials. (See claims 6 and 7) Hooks teaches a method of delivering interactive content for commercials rather than subsequent access to the commercial message. In another example, Applicants request that the Examiner clarify which portion of Barton paragraphs [0045-0060] teaches the commercial message being extracted for subsequent access by a user as this does not seem to be taught. (See OA mailed 5/13/10, p. 8) Thus, the systems and methods taught by Nafeh, Wordemann, Hooks, Dimitrova, and Barton differ in functionality and purpose from that claimed by Applicants. Thus, claim 1 should be allowed over the cited art.

The previous Office Actions fails to establish a prima facie case of obviousness against Claims 1, 27, and 55 because the combination of the cited references does not disclose or even suggest all the limitations of the claims particularly directed at extracting and recording the commercial message (or signal) for subsequent play back based on a user selection.

Similarly, claim 1 also includes “display means for displaying said index, the display means further displaying a selected commercial message audibly and/or visually in response to a user selection from the index.” In the cited art, the commercial messages are not recorded to be played back “audibly and/or visually in response to a user selection from the index.” Rather, commercials are removed or skipped to prevent interruption of other media content as explained above. As a result, claim 1 should be allowed.

For at least these reasons, claims 27, and 55 should be allowed. Claims 2-12, 14-26, 28-38, and 40-54 should be allowed at least based on their dependence on claims 1 and 27, respectively.

II. **Conclusion**

In view of the above amendments and remarks, Applicants submit that claims 1-12, 14-38, and 40-55 are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Applicants believe that no additional fee is due with the filing of this Response. However, if Applicants have overlooked the need for a fee, including a fee for an extension of time under 37 C.F.R. 1.136(a), the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 19-3140 of Sonnenschein Nath & Rosenthal LLP, referencing Attorney Docket No. 09792909-5003.

If the claims are not found to be in condition for allowance, the Examiner is requested to contact the undersigned to schedule an interview before the mailing of the Office Action. Any communication initiated by this paragraph should be deemed an Applicant initiated interview.

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Respectfully submitted,

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